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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,883	11/07/2001	Marcie Natale	M 6401A-OS/PS	8318

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COGNIS CORPORATION  
2500 RENAISSANCE BLVD., SUITE 200  
GULPH MILLS, PA 19406

EXAMINER
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EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1713

3

DATE MAILED: 02/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/010,883

Applicant(s)

NATALE ET AL.

Examiner

Dr. Kelechi C. Egwim

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 16-33 is/are pending in the application.
- 4a) Of the above claim(s) 17,21-23,32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16,18-20 and 24-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 16-33 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 07 November 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 16 and 26 are generic to a plurality of disclosed patentably distinct species comprising:

la) wherein A is epihalohydrin (claims 21-23, 32 and 33)

lb) wherein A is trihaloalkane.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

2. Also, this application contains claims directed to the following patentably distinct species of the claimed invention:

IIa) wherein the reaction product is added prior to emulsion polymerization. Claim 17

IIb) wherein the reaction product is added subsequent to emulsion polymerization. Claim 18

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 16 is generic to these species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

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is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

3. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. During a telephone conversation with John Drach on 1/21/03, a provisional election was made with traverse to prosecute the invention of species b) in genus I and species b) in genus II, claims 16, 18-20 and 24-31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17, 21-23, 32 and 33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Priority***

6. This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior application. A statement reading "This is a divisional of Application No. 09/363,555, filed 7/29/1999" should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of all nonprovisional parent applications referenced should be included.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 16, 18-20 and 24-31 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the combination of epichlorohydrin with an alkoxylated alcohol in a reaction mixture, does not provide enablement for a particular "reaction product". The specification contains no actual or derived structure for the claimed "reaction product". The specification does not enable any person skilled

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in the art to which it pertains, or with which it is most nearly connected, to **recognize and/or use** the "reaction product" of the invention commensurate in scope with these claims. Applicant has not given any evidence of the claimed "reaction product" or any evidence that **any particular** "reaction product" would be realized.

9. Further, even if applicant did provide evidence of the claimed "reaction product" or any evidence that a particular "reaction product" from the recited A) and B) would be realized, the specification does not reasonably provide enablement for **all possible reaction products** that may be produced involving at least one A) and at a least one B). As both A) and B) are common reagents, there are a multitude of products produced from reaction mixtures comprising at least one of each. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use each and every product produced from at least one A) and at a least one B) as **an emulsion stabilizer**, commensurate in scope with these claims.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 16, 18-20 and 24-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al. (USPN 5,250,609) in combination with Nakamura et al. (JP 60019030).

In the abstract, col. 3, lines 53-55 and col. 6, line 43-54, Kato et al. teach a composition prepared by adding 0.01 to 0.5 parts per 100 of a wetting agent to an aqueous composition of an vinyl acrylic emulsion polymer prepared in the presence of an emulsifier.

Kato et al. differ from the claimed invention in that the wetting agent is not specified as the present wetting agent "reaction product". However, it is known in the art to use the present reaction product as a wetting agent (or emulsifier), for the purpose of providing excellent surface activity, such as taught by Nakamura et al. (see abstract)

In the abstract, Nakamura et al. teach a wetting agent/emulsifier/surface active agent comprising the reaction product of one mole of epihalohydrin per one mole of a polyalkoxylated alcohol (1:1 ratio), wherein R is an alkyl group having from 8 to 24 carbon atoms and n is a number of from 1 to 50.

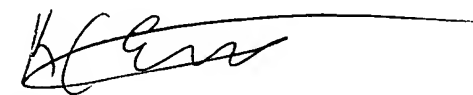
Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made, to use the wetting agent reaction product of Nakamura et al. in the emulsion polymer composition of Kato et al. in order to obtain the advantages taught by Nakamura et al., motivated by a reasonable expectation of success.

Regarding claim 31, it is noted that degree of polymerization represents the number of monomer units in an average polymer in a given sample. As such, with only one reaction of two monomers, a degree of polymerization of 2 is achieved.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to be 'KCE', with a long horizontal line extending to the right.

KCE  
January 22, 2003